

**REMARKS**

At the time of the Office Action dated March 17, 2004, claims 1-12 were pending. Of those claims, claims 7-10 have been withdrawn from consideration pursuant to the provisions of 37 C.F.R. §1.142(b).

In this Office Action, claims 1-3 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Jiang et al. in view of Taguchi et al. However, claims 11 and 12 added by the Amendment dated December 18, 2003 have not been considered in this Office Action. With respect to claims 11 and 12, Applicants acknowledge, with appreciation, Examiner Parekh's courtesy in conducting a telephonic interview on April 2, 2004. It is Applicants' understanding that claims 11 and 12 will be considered and new non-final Office Action will be issued if there is any reason for rejection of the claims. Attached is the December 18, 2003 Amendment for the Examiner's reference.

In addition, Applicants note that the following limitation recited in claim 1 is not considered in this Office Action.

said adhesive layer extends outside an outer edge of the primary surface of said semiconductor element without reaching an outer edge of the primary surface of said circuit board, said adhesive layer extending outward relative to and completely all the way around the primary surface of said semiconductor element to cover an area of the circuit board under which all the external electrodes are disposed (emphasis added).

Applicants respectfully request the Examiner to consider the above limitation, i.e., the December 18, 2003 Amendment. It is also submitted that the applied combination of Jiang and Taguchi et al. does not teach or suggest a semiconductor device including the above limitation. Jiang does not teach an adhesive layer covering an area of a circuit board under which all external electrodes are disposed. Taguchi et al. does not teach an adhesive layer extending outside an outer edge of a primary surface of a semiconductor element without reaching an outer edge of a

primary surface of a circuit board, and covering an area of the circuit board under which all external electrodes are disposed.

It is noted that the claimed invention enhances the reliability of a semiconductor device because the adhesive layer relieves tension between the semiconductor element and the circuit board. In addition, if there is a sealing resin as claimed in claim 2, claimed invention also enhances the reliability of a semiconductor device in that the adhesive layer and the sealing resin is prevented from separating due to moisture absorption and so on. The applied combination of Jiang and Taguchi et al. does not teach or suggest the above aspects.

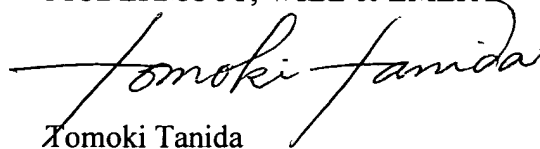
Applicants, therefore, respectfully solicit favorable consideration of claims 1-3, 11 and 12.

Further, the Examiner's attention is directed to the Attorney Docket No as being 50090-240, not 500-0-240 as indicated in the Office Action. Correction is respectfully requested.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

MCDERMOTT, WILL & EMERY

A handwritten signature in black ink, appearing to read "Tomoki Tanida", written over a horizontal line.

Tomoki Tanida

Recognition under 37 C.F.R. 10.9(b)

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**Date: June 9, 2004**


**BEFORE THE OFFICE OF ENROLLMENT AND DISCIPLINE  
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**Expires: July 24, 2004**

  
Harry I. Moatz  
Director of Enrollment and Discipline

Applicant: Kazuyuki NAKAGAWA, et al.Docket No. 50090-240Title: SEMICONDUCTOR DEVICE HAVING AN IMPROVED MOUNTING STRUCTURESerial/Reg./Patent No. 09/665,415Date Sent 12/18/03 ☒ Hand Carried ☐ Fax ☐ Electronic ☐ Cert. of Mailing ☐ Express Mail No. \_\_\_\_\_☒ Transmittal LetterNew Patent App ☐ Utility ☐ Design ☐ Cont. ☐ CIP ☐ Div. ☐ PCT ☒ RCE ☐ Prov☐ Other: \_\_\_\_\_

\_\_\_\_\_ pages of Specification

\_\_\_\_\_ pages of Claims

\_\_\_\_\_ pages of Abstract

\_\_\_\_\_ pages of Formal/Informal Drawings

☐ Small Entity ☐ Large Entity☐ Declaration/Power of Attorney☐ Recordation of Assignment/Security Agreement☐ Information Disclosure Statement

Form PTO 1449

\_\_\_\_\_ copies of cited references

☐ Preliminary Amendment☐ Response to Missing Parts Notice☐ Resp. to Notice to Correct App. Papers☐ Certified Copy of Priority Doc.☐ Claim for Convention Priority☒ Response/Amendment to Office Action of 9/26/03☐ Request for \_\_\_\_\_ month Extension of Time☐ Letter submitting \_\_\_\_\_ pages of drawings☐ Req. for Approval of Drawing Amendments☐ Req. for Oral Hearing☐ Not. of Appeal ☐ Appeal Brief ☐ Reply Brief☐ Rule 312 Amendment/Letter☐ Req. for Acknowledgement of Cited Art☐ Issue Fee☐ Publication Fee☐ Req. for Certificate of Correction☐ Maintenance Fee for \_\_\_\_\_ years after grant☐ Fee Address Indication Form \_\_\_\_\_☐ Terminal Disclaimer☐ Petition to Commissioner☐ Status Inquiry☐ Other \_\_\_\_\_

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JUN 15 2004

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